REMARKS/ARGUMENTS

Reconsideration of the above-identified patent application is respectfully requested in view of the foregoing amendments and the following remarks. Claims 1 and 9 - 11 were amended. Claims 1 - 11 remain in the application.

Applicant first wishes to thank Examiner Tran for his withdrawal of the rejections of the previous Office Action (Paper No. 6) based upon Applicant's Declaration in accordance with 37 C.F.R. §1.131. In addition, Applicant wishes to thank Examiner Tran for the courtesy extended to David Banner, Agent for Applicant, during the office interview with him on March 23, 2003.

Applicant wishes to remind Examiner Tran that in his Declaration under 37 C.F.R. §1.131 filed on August 8, 2003, he established a date of invention of the subject matter of the instant application no later than August 28, 1993. Three of the references cited in the Office Action of October 29, 2003 (Paper No. 14) have filing dates more than one year later than August 28, 1993, specifically AKIYAMI '356; JARLANCE-HUANG '574; and PALEY '605. Nonetheless, Applicant has chosen to overcome these references by claim amendment at this time but reserves the right to file an additional Declaration under 37 C.F.R. §1.131 to remove these references from consideration as well.

Applicant respectfully requests that Examiner Tran changes the Attorney Docket No. associated with the instant application to TD-101 to maintain compatibility with the undersigned's docket number assignment and filing system.

Claims 1, and 4 - 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,668,574 for PALM-TOP WIRELESS TRACKBALL, issued September 16, 1997 to Jarlance-Huang (hereinafter HUANG), in view of United States Patent No., 5,506,605 for THREE-DIMENSIONAL MOUSE WITH TACTILE FEEDBACK, issued April 9, 1996 to W. Bradford Paley. HUANG teaches a hand held control device having a thumb-actuated trackball and a plurality of finger operated switches.

The housing as seen in HUANG Figure 2 appears to be significantly longer and of greater circumference than Applicants miniature device as shown in Figure 1a of the instant application. HUANG neither teaches nor suggests that the HUANG device may be held or secured to a user's hand leaving the

fingers and thumb free to perform other tasks not involving the pointing device. Applicant's pointing device has specifically been designed to allow it to remain properly positioned in a user's hand, even when not secured thereto, while that hand, specifically the fingers of that hand are used to perform other tasks.

The switches of the HUANG apparatus are not actuated by the metacarpal (i.e., first phalangal) region of the user's fingers. Rather, the user must use his or her finger tips to actuate the HUANG switches. This difference in actuation is caused by the different shape of the HUANG housing and the position of the switches thereupon compared to Applicant's structure and switch placement. This significant shape differences as well as the different relative position of the HUANG housing relative to the user's hand also appears to preclude retaining the housing to the user's hand by the thumb, or, in fact, even with an elastic band as taught by Applicant. Because, even if attached, the size and shape of the HUANG housing and the difference in finger position during use teach away from Applicant's miniature pointing device which nestles in the hand while allowing a substantially complete range of movement of the post-metacarpal regions of a user's fingers, even with the inventive pointing device in the hand.

The PALEY housing does not appear to be symmetrical and there is no specification support for housing symmetry. PALEY, however, claims "ambidextrous deformable means" but offers no explanation thereof. It is also unclear to the Applicant whether some modification must be made to the PALEY apparatus to change it from left to right hand operation (or vice-versa). In addition, the PALEY housing is adapted for use in three-dimensional space and, consequently requires a substantially vertical orientation when in use. Clearly, the PALEY housing could not be retained in a user's hand while leaving that hand free to perform other tasks - the bulky forward portion of housing 12 would probably interfere (i.e., bump) whatever that user attempted to touch or actuate with the post-metacarpal regions of his or her fingers. Consequently, even if a user were to secure the PALEY housing to his or her hand, he or she would still be unable to use that hand for other, non pointing device tasks. In addition, like the HUANG point device, the PALEY apparatus has switches that are not actuated by the metacarpal region but rather by the index finger tips/thumb tips, or even by multiple finger tips on a single switch.

There would be no motivation whatsoever to combine the teaching of HUANG with that of PALEY. The resulting pointing device is envisioned to be cumbersome and unwieldy and would

certainly not have Applicant's disclosed and claimed features. Even if the features of HUANG and PALEY are combined, there is nothing that obviates Applicant's miniature pointing device which rests snugly in the palm of a user's right or left hand interchangeably and, when either held in place by the user's thumb or strapped in place, leaves that hand free to perform other tasks.

The wireless communications device, recited in claims 4 -9 is merely an added limitation to a base claim now believed to be allowable. The fundamental novelty of Applicant's pointing device is not based upon the method by which an electrical signal reaches the computer or other electrical device to which the pointing device is operatively interconnected, but in the unique housing shape, size, and in the placement of the pointing device's switches.

Claim 1 has been amended to positively recite the position of the inventive pointing device in a user's hand and that the housing may be retained in position thereby freeing the remainder of the fingers of the user's hand to perform other tasks when the inventive pointing device is so positioned. It is believe that the amendment of claim 1 overcomes the rejection thereof us being unpatentable under 35 U.S.C. §103(a) over HUANG in view of PALEY. Claims 4 - 9 depend from claim 1 and are likewise now believed to be allowable.

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over HUANG in view of PALEY and further in view of United States Patent No. 5,982,356 for ERGONOMIC COMPUTER CURSOR CONTROL APPARATUS AND MOUNT, issued November 9, 1999 to Robert Akiyama. AKIYAMA teaches a vertically mounted manpulandum (i.e., joystick) actuated pointing device on the planar upper surface of the apparatus. Two input control buttons are arranged to be actuated by "an index finger tip and a middle finger tip (column 2, line 57). AKIYAMA neither teaches nor suggests that the disclosed apparatus could be used interchangeable by a right- or left-handed operator. The location of switches 48 and 50 appear to be on the side of the housing (best seen in AKIYAMA Figure 2) requires finger tip (not a metacarpal region of a finger) actuation thereof.

In addition, the fixed placement of the AKIYAMA apparatus (i.e., supported on upright support element (i.e., post) 18 of planar mounting element 16 precludes securing the AKIYAMA pointing device to a user's hand as the user's hand would be immobilized by support elements 16 and 18. AKIYAMA, therefore, teaches away from Applicant's inventive pointing device.

For at least these reasons, the addition of the teaching AKIYAMA to that of HUANG and PALEY still fails to teach Applicant's novel pointing device. In fact, AKIYAMA teaches away from Applicant's device so that the combination with HUANG and PALEY results in a combination even more different than Applicant's structure than does the HUANG and PALEY combination alone. Applicant believes, therefore, that the amendment of claims 1 et al. overcomes the rejection of claims 2 and 3 under 35 U.S.C. §103(a) as being unpatentable over HUANG and PALEY in view of AKIYAMA.

Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over HUANG and PALEY in view of United States Patent No. 5,267,181 for CYBERNETIC INTERFACE FOR A COMPUTER THAT USES A HAND HELD CHORD KEYBOARD, issued November 30, 1993 to Christopher S. George. GEORGE discloses a hand-held keyboard suitable for securing to a user's hand. A keypad is dispose for actuation by the tips of a user's fingers. The relative size of the GEORGE device appears to preclude allowing a user to use their fingers and thumb for other non-keyboard related tasks while the GEORGE device is affixed their hand. This is different than Applicant's hand-held pointing device which, when in operating position in a users right or left hand, allows usage of the user's fingers and thumb even while the inventive pointing device is secured in the user's hand.

Applicant believes, as already discussed hereinabove, that the combined teaching of HUANG and PALEY fails to suggest his innovative pointing device. The addition of the teaching of GEORGE to that combination would seem to suggest a cartoon-like unwieldy kludge rather than the compact, highly useable pointing device described and claimed by the Applicant.

Applicant believes that the amendments to the claims already discussed overcomes the rejection of claims 9 and 10 and being unpatentable under 35 U.S.C. §103(a) over HUANG and PALEY in view of GEORGE.

Applicant believes that claims 1 - 11 are now in condition for allowance and respectfully requests that they be timely allowed and the application passed to issue.

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On March 29, 2004
(Date of Deposit)

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